

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re application of: Bruchman et al.
Serial No.: 09/811,987
Group Art Unit: 1711
Filed: March 19, 2001
Examiner: Sergeant, Rabon
For: HIGH-FUNCTIONALITY ISOCYANATES

PETITION FOR REVIVAL OF ABANDONED APPLICATION

Mail Stop PETITIONS
Commissioner for Patents
P.O. Box 1450
Alexandria, Virginia 22313-1450

Dear Sir:

The above-identified application became abandoned for failure to file a timely and proper reply to a notice or action by the United States Patent & Trademark Office and a Notice of Abandonment, dated January 12, 2007, was received. In response to this Notice of Abandonment, the Applicants hereby petition to revive the present application. The Applicants are petitioning first under the unavoidable standard pursuant to 37 CFR § 1.137(a).

The delay in reply by the Applicants was unavoidable as evidenced by the following information. This information establishes an adequate showing of the cause of the unavoidable delay.

- In the Non-final Office Action dated April 15, 2003, the Examiner indicated that claim 3 was objected to. Specifically, claim 3 was objected to as being dependent upon a base claim, i.e., claims 1 and 2. However, it was clearly indicated that claim 3 would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.
- In the Final Office Action dated January 30, 2004, the Examiner again indicated that claim 3 was still objected to, but would be allowable if rewritten in independent form, as previously described above.

- After the Request for Continued Examination, the Examiner indicated that claim 3 was still objected to in a Non-final Office Action dated July 15, 2004. However, just as described above, it was again indicated that claim 3 would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.
- In the Advisory Action before the filing of the Appeal Brief dated August 10, 2005, the Examiner indicated that claim 3 was still in the form where it was only objected to, i.e., it would be allowable if rewritten in independent form.
- In the Appeal Brief dated October 18, 2005, and also in the Amended Appeal Brief dated February 3, 2006, the Applicants described the status of the claims for the present application. Specifically, the Applicants stated that claim 3 was still in original form and had been objected to as dependent on a rejected base claim but had been indicated by the Examiner as allowable if rewritten, as previously described in the Office Actions and the Advisory Action above.
- In the Examiner's Answer dated April 20, 2006, the Examiner again indicated that "the summary of claimed subject matter contained in the brief is correct", thereby concurring with the Applicants' summary of the ultimate allowability of claim 3.
- In the Decision On Appeal of the Board of Patent Appeals and Interferences (BPAI) dated September 28, 2006, the BPAI stated that "[c]laim 3, also of record, has been held by the Examiner to encompass patently subjected matter but is objected to as being dependent on a rejected claim", i.e., claim 3 itself was not rejected under any statutes including 35 U.S.C. § 112.
- In response to the Decision on Appeal, with it in mind that in one form or another claim 3 had been indicated as being allowable no less than 5 times by both the Examiner and the BPAI, the Applicants filed the Amendment After Appeal, in accordance with MPEP 1214.07, dated November 24, 2006. The Applicants amended claim 3 merely to accept all of the Examiner's previous indications as previously described above, that claim 3 had allowable subject matter and if rewritten in independent form including the limitations of claim 1, claim 3 would be allowable.
- In several communications with the Examiner in November and December 2006, the Examiner contended that moving claim 3 into claim 1 introduced 35 U.S.C. § 112 issues. This position by the Examiner was surprising to the Applicants because a 35 U.S.C. § 112 rejection on claim 3 had never been presented before.
- In a voicemail message dated December 6, 2006, the Examiner indicated that the present application went abandoned as of two months from the Decision on Appeal, i.e., on November 28, 2006, since the Amendment After Appeal did not serve to put the case in

condition for allowance. The Examiner further indicated that he no longer had jurisdiction to remedy claim 1 by an examiner's amendment, and therefore suggested a Petition to Revoke the present application.

- In the Notice of Abandonment, dated January 12, 2007, the Examiner confirmed and elaborated why, in his opinion, the Amendment After Appeal did not serve to put the case in condition for allowance. Specifically, according to the Examiner, the amended claim 1 raised issues of indefiniteness under 35 U.S.C. § 112, second paragraph. Notably, as described above, issues of indefiniteness were never previously raised by the Examiner regarding the objected to claim 3 prior to the Amendment After Appeal. Relying on the Examiner's previous indications of allowance for the Amendment After Appeal, the Applicants merely rewrote claim 3 in independent form including all of the limitations of claim 1, i.e., the base claim. Without prior notice of any issues regarding indefiniteness, the Applicants had no reason to amend before the present application went abandoned.
- The Notice of Abandonment was not received by the Applicants until January 19, 2007 and since the receipt of the Notice of Abandonment, the Applicant has been confirming the various facts present within the file history and has been preparing the subject Petition.

In view of the foregoing, the Applicants respectfully submit that an adequate showing of the cause of the delay has been set forth above. Specifically, the Applicants merely complied with all of the Examiner's previous indications of allowance by precisely rewriting claim 3 in independent form with all of the limitations of claim 1 within two months of the Decision on Appeal, and therefore the Amendment After Appeal should have been deemed proper. The Applicants were unaware of any additional objection to claim 3, specifically the issues of indefiniteness indicated by the Examiner in the Notice of Abandonment, and merely relied on all of the Examiner's previous indications for obtaining allowance of claim 3. The issue of indefiniteness was not officially raised on the record until the Notice of Abandonment.

The Applicants are convinced that abandonment of the present application and the entire delay in filing the required reply from the due date for the reply until the filing of the subject Petition was unavoidable, as fully detailed in the information set forth above. Thus, the Applicants respectfully request that the present application be revived pursuant to 37 CFR § 1.137(a).

While, as indicated above, the Applicants are convinced that the burden of proof required pursuant to 37 CFR § 1.137(a) has been satisfied, the Applicants respectfully request, in the alternative, a Petition to Revoke under the unintentional standard pursuant to 37 CFR § 1.137(b). In the case of this alternative, the entire delay in filing the required reply from the due date for the required reply until the filing of the subject Petition under 37 CFR § 1.137(b) was unintentional.

This Petition to Revive is also submitted with a Request for Continued Examination (RCE). Upon grant of this Petition to Revive, the Applicant's respectfully request that the RCE be accepted and the Amendment After Appeal dated November 24, 2006 be entered.

The Commissioner is authorized to charge the \$500.00 fee pursuant to 37 CFR § 1.137(a), or in the alternative, the \$1500.00 fee pursuant to 37 CFR § 1.137(b), and the \$790.00 fee pursuant to 37 CFR § 1.114 to Deposit Account No. 08-2789 in the name of Howard & Howard. If any additional fees are necessary to revive the present application, you are hereby authorized to charge such fees to Deposit Account No. 08-2789 in the name of Howard & Howard.

Respectfully submitted,

HOWARD & HOWARD ATTORNEYS

February 23, 2007

Date

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